



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/770,705

01/26/2001

Christopher S. Gouge

MS155721.2

6801

27195

7590

09/27/2005

AMIN & TUROCY, LLP  
24TH FLOOR, NATIONAL CITY CENTER  
1900 EAST NINTH STREET  
CLEVELAND, OH 44114

EXAMINER

INGBERG, TODD D

ART UNIT

PAPER NUMBER

2193

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/770,705

Applicant(s)

GOUGE ET AL.

Examiner

Todd Ingberg

Art Unit

2193

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

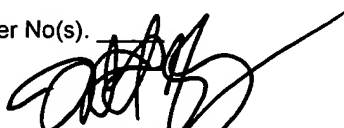
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).  
13. ☐ Other: \_\_\_\_\_.

  
Todd Ingberg  
Primary Examiner  
Art Unit: 2193

## ADVISORY ACTION

### *Response to Arguments*

1. Applicant's arguments filed August 29, 2004 have been fully considered but they are not persuasive. Applicant's remarks (scanned) with Examiner's response as follows:

#### "REMARKS

Claims 1-24 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

#### I.. Rejection of Claim 23 Under 35 U.S.C. § 101

Claim 23 stands rejected under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Withdrawal of this rejection is requested for at least the following reasons. Claim 23 produces a useful, concrete and tangible result, and further, the subject claim pertains to the transmission of software code between two or more computer processes.

Because the claimed process applies the Boolean principle [abstract idea] to produce a useful, concrete, tangible result ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); See *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "useful." *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1:544, 31 U.S.P.Q.2D (BNA) 15,45, 1557 (Fed. Cir. 1994) (emphasis added).

The Examiner contends: "[a] communications signal transmitting between two computers a data packet is not tangible." Applicants' representative disagrees and submits that the Examiner is misconstruing the requirements necessary to fulfill the conditions for patentability under 35 U.S.C. § 101. According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the standard set forth by the Federal Circuit for determining whether claims are directed towards statutory subject matter is whether the claims as a whole can be applied in a practical application to produce a useful, concrete and tangible result. It is the result of the claims as applied in a practical application that is germane to the determination of whether the claims are directed towards statutory subject matter, not whether the underlying means by which the result is effectuated that should be tangible, as the Examiner intimates. It is believed therefore that the subject claim clearly satisfies this legal standard. In particular, independent claim 23 recites: a data packet transmitted as a communication signal between at least two computer processes, comprising: a configurable module having: one

Art Unit: 2193

or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. Thus, claim 23 elicits a series of independent acts that culminates in a useful, concrete and tangible result - the installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. “

#### Examiner's Response

On the issue of rejection under 35 USC § 101. Examiner merely implement policy not construe policy. Recent changes in PTO policy have altered the policy on “*carrier waves*” in some claim formats. The basis of this rejection is the lack of a tangible format of the invention. There is a lack of having the invention tangibly embodied on a computer readable medium. The transmission of the data packet is between two computer processes no mention of the hardware which would tangibly embody the invention. Also, Applicant focuses on the result alone in the response. A simple amendment in the preamble would eliminate this rejection. And would be entered on Appeal if Applicant elects to appeal.

#### Applicant's Remarks

“Additionally, the Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Title 35, section 101, explains that an invention includes “any new and useful process, machine, manufacture or composition of matter.” ... Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes. *Id.* at 1338 (emphasis added).

The subject claim clearly pertains to software code comprising a configuration module, one or more configurable data elements, one or more non-configurable data elements, and one or more transformation instructions encapsulated in a data packet transmitted from one computer process to another computer process, so that the transformation instructions therein can be employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes. The fact that (i) the data packet that encases the software code during its transmission between two processes, or (ii) the data packet is transmitted as a communication signal between two processes is irrelevant to the fact that it is software

code that is contained therein and is being transmitted through utilization of a communication signal. It is submitted that all that is relevant is the fact that software code is being transmitted within the data packet, and that the software code so transmitted produces a useful, concrete and tangible result Accordingly, withdrawal of this rejection is requested.”

#### Examiner's Response

Art Unit: 2193

The claims is for transmitting a data packet between two computer processes. A data packet has an inherent data structure. Case law used by Applicant states " ... *Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes. Id. at 1338 (emphasis added).* ". A data packet is not software code. In Applicant's case the contents of the data packet is configurable code but is treated as data since it is not executing it is data within a data structure being transmitted. Applicant's own case law fails to support their position.

### **Disposition on the Rejection under 35 USC § 101**

There have been recent changes ( as in since the Final Action) in PTO policy in regard to 101 claims with the limitation of "**carrier waves**". No change has been reported to date on the issue of transmitting "data packets". In support of the PTO examination policies on the issue of 101 the rejection to date is maintained.

### Applicant's Remarks as to the Rejection Under 35 U.S.C. § 102

"II. Rejection of Claims 1-24 Under 35 U.S.C. & 102(b)

Claims 1-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Microsoft's Visual C++ version 5.0 as documented in the text book, "Beginning Visual C++ 5", by Ivor Horton, published March 19, 1997 (hereinafter "Horton!"). This rejection should be withdrawn for at least the following reasons. Horton does not disclose or suggest each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-US.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See *Yerdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987, 1. The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added)."

### Examiner's Response to the "standard of identical"

The MPEP states the following:

"2131 [R-1] Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)  
35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, or
  - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or
  - (c) he has abandoned the invention, or
  - (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- \*\*>

- (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a

Art Unit: 2193

patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or<

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

#### TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

The claims must clearly and concisely distinguish themselves from the prior art of record.

One of the best ways to for Applicant to distinguish themselves is to point to the Specification and explain why the interpretation of the Examiner of the terms and teaching of the prior art do not apply. The Specification can not be read into the claims but when used to distinguish how the terms of the prior art fail to meet the meaning of the terms of the invention, often serve to distinguish the invention over prior art of record. In conclusion, in *Richardson vs. Suzuki* *Richardson* started with a motorcycle and altered the suspension. The court found the end result

Art Unit: 2193

was not the *exact* same as the prior art Richardson started with (a motorcycle). Applicant has not disclosed what they started with to see the improvement they have made.

#### Applicant's Remarks

"Applicants' claimed invention relates to a system and method for configuring software components that are incorporated into computer programs. In particular, the subject invention relates to creating, describing and configuring software components (that are data sets) that are to be incorporated into software programs (target data sets) such that the components are self-describing in relation to configuration possibilities for the software components. To this end, independent claims 1, 9, 13, 17, 22, 23 and 24 recite similar limitations, namely: ... installation of the one or more configurable data elements into at least one target data set. Horton does not disclose or suggest these novel aspects of the invention as claimed.

The Examiner contends that Horton provides substantiation for the rejection of the subject claims. Applicants' representative disagrees. Horton discloses the creation and utilization of dynamic link libraries, and specifically that a dynamic link library is a file containing a collection of modules that can be used by any number of different programs. (See page 717, lines 1-2). The cited document further discloses that no code from the dynamic link library is ever included in the executable module of any of the programs, such that when one of the programs is executed, the program is loaded into memory, and if the dynamic link library that the program utilizes is not already present, in memory, it too is loaded separately into memory. (See page 718, lines 2-5). Horton also specifically notes that when a program calls a function in a dynamic link library, the operating system will automatically load the dynamic link library into memory, and as a consequence, since the operating system recognizes that the library is already in memory, any program that is subsequently loaded into memory that utilizes the same dynamic link library can use any of the capabilities provided by the same copy of the dynamic link library; all that is required is that links between the program and the dynamic link library be established. The cited document further notes that when a dynamic link library is no longer used by any executing program, the operating system will automatically delete the dynamic link library from memory. (See page 718, lines 8-15)- From the foregoing it is apparent that the dynamic link library as disclosed in Horton is a separate, distinct and transient entity that is loaded into memory to operate in conjunction with a program that is also loaded into memory, and that once the dynamic link library has fulfilled its purpose it is deleted from the memory. The invention as claimed in contrast, installs and/or loads configurable data elements into a target data set through the use of transformational instructions applied to configurable data elements to transform the target data set with the configurable elements obtained from a transformation component, e.g., when the configurable data elements are installed and/or loaded into a target data set there is a transformation in that- the target data set is no longer the entity it was prior to utilization of the claimed invention; the target data set now has installed therein configurable data elements."

#### Examiner's Response

There are three main arguments in this section.

Art Unit: 2193

First, independent claim 1 is directed toward "software installation". Applicant states the *"The cited document further discloses that no code from the dynamic link library is ever included in the executable module of any of the programs, such that when one of the programs is executed, the program is loaded into memory, and if the dynamic link library that the program utilizes is not already present, in memory, it too is loaded separately into memory"*. The prior art shows the mechanism which DLLs (which are well known in the art) merge with existing software. The merging is performed with pointers. The claim limitations do not distinguish themselves from the well known techniques employed in the use of DLLs.

Second, the ability (also note it may also work with only one) of a DLL to be used by more than one program seems to be a point being confused by the argument when mentioning the loading into memory. The claims are silent as to the loading of memory when running the invention. Applicant is arguing a point that is not in the claims and may not be supported in the Specification.

Third, the mentioning that the operating system can remove no longer needed DLLs is also not a limitation in the prior art that the claimed invention distinguishes itself over. The claimed invention makes no mention of the use of memory or garbage collection (often called a sweeper routine). Returning to the claim for a data packet. Applicant should also recognize the data packet is also a reclaimed resource.

#### Applicant's Remarks

"Additionally, it is evident that the program and the dynamic link library that are loaded into memory always remain distinct entities. In particular, the definitional section provided by the Examiner, via. Term's in the Art, reinforces the perception that the dynamic link library and the program always remain separate and distinct entities in that definition (A) provides that dynamic link libraries are "executable routines [that are] stored separately as files . . . [and are] loaded when needed by a program", and definition (B) states that a dynamic link library is "a file containing executable code and data bound to a program at load time, or run time, rather than during linking." The import of these two definitions is that they are an indication that dynamic link libraries are never installed within to the target/invoking program, but rather that the invoked dynamic link library is merely linked to the invoking program, at some point when the functionality of the dynamic link library is required. Thus, it is submitted that the dynamic link library always remains distinct from the target invoking program, and that the dynamic link library is never installed into the target/invoking program.

In addition, the Examiner in the Response to Arguments section of the Final Office Action dated June 28, 2005, states "the end result of the merge of the content of the DLL (software AND/OR data) is the content of the DLL is merged into a target data set (the software component(s)) program which the content is being modified." Id. at page 8. Horton does not teach or suggest that there is a merger of the dynamic link library into the target data set/program, and neither do the definitions upon which the Examiner places reliance. All that Horton (and the definitions provided by the Examiner) discloses is that dynamic link libraries are loaded into memory when needed by an invoking program, and that links are created between the invoking program and the dynamic link library invoked. Nowhere in Horton is there a



Art Unit: 2193

discussion of merging the dynamic link library into the calling program let alone installing one or more configurable data elements into at least one target data set as recited in the subject claims.”

Examiner's Response

As prior the Applicant's claim limitations make no reference to the arguments made. Claims language must be clear and concise and supported by the Specification. Applicant has neither claimed the limitations argued nor have they provided evidence the Specification supports a difference.

Applicant's Remarks

“Furthermore, the Examiner is reminded that the standard by which anticipation is to be measured is strict identity between the cited document and the invention as claimed, not mere equivalence or similarity. See, Richardson at 9 USPQ2d 1913,1920. This means that in order to establish anticipation under 35 U.S.C. § 102, a single document must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the identical invention must be shown in as complete detail as contained in the claim. Horton alone, despite the supposed "Term's in the Art" supplied by the Examiner, does not provide the required identity to substantiate this rejection under 35 U.S.C. § 102. In particular, the cited document does not provide for the installation of configurable data elements into a target data set thereby rendering a single indivisible entity - a software program that also includes configurable data elements installed therein.

In view of at least the foregoing, it is respectfully requested that the rejection of independent claims 1, 9, 13, 17, 22, 23 and 24 (and claims that depend there from) should be withdrawn.”

Examiner's Response

As stated in the Final action. The case law of Richardson was based on the Applicant starting with an existing product, a motorcycle and modifying the suspension. Applicant has not disclosed a known product that they are altering.

The “Terms of the Art” section has not been argued. An argument would require the Applicant to distinguish the terms by point to the Specification and describe the difference to distinguish that the terms are different or a reference. Applicant has not made a proper challenge in the record the terms are taken as fact. In re Chevenard, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943). A proper challenge was supposed to be timely. The following is from the MPEP 2144.03(b). “The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.”

Disposition of Rejection under 35 U.S.C. § 102

The majority of Applicant's arguments are not connected to claimed limitations and appear not to be supported by the Specification. Applicant's arguments are not deemed persuasive.

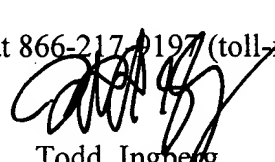
Art Unit: 2193

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Todd Ingberg  
Primary Examiner  
Art Unit 2193

TI